

Application No. 09/975,428

RXSD 1017-1

REMARKS

In the Official Action mailed 22 October 2003, the Examiner objected to the specification because it contains embedded hyperlinks in paragraphs 4 and 5. The Examiner also objected to the specification because of informalities in paragraph 1. The Examiner reviewed claims 1-32. The Examiner has objected to claims 1 and 13 for informalities, has rejected claims 1, 2, 4, 12 and 22 under 35 U.S.C. §102(e), has rejected claim 3 under 35 U.S.C. §103(a); has rejected claims 5-11 and 23-26 under 35 U.S.C. §103(a); has rejected claims 13-15 and 27 under 35 U.S.C. §103(a); has rejected claims 16-20 and 28-32 under 35 U.S.C. §103(a); has provisionally rejected claims 1-3, 7, 12, 22 and 24 under the judicially created doctrine of obviousness-type double patenting; and has provisionally rejected claims 13-15, 18, 21, 27 and 30 under the judicially created doctrine of obviousness-type double patenting.

Applicant has amended claims 1, 4-11, 13, 16-20, 22-25 and 27-32. Claims 1-32 remain pending.

Objection to the Specification

The Examiner has objected to the specification because it contains embedded hyperlink and/or other form of browser-executable code. Applicant has reviewed the application and finds that paragraphs 4 and 5 of the specification refer to web sites by the www.---.com form. However, these references are not hyperlinks according to the MPEP Section 608.01(a). Hyperlinks are preceded by the symbols "<" and followed by the symbol ">", or preceded by "http://". These symbols are not used in the specification.

The Examiner required information to be entered in the blanks in paragraph 1. The paragraph has been amended herein to contain the appropriate serial numbers and filing dates.

Accordingly, reconsideration of the objection to the specification is requested in view of the arguments and amendments.

Rejection of Claims 1, 2, 4, 12 and 22 under 35 U.S.C. §102(e)

Claims 1, 2, 4, 12 and 22 are rejected under 35 U.S.C. §102(e) as being anticipated by Horn. Applicant has provided clarifying amendments to the claims, without loss of scope. The independent claims 1 and 22, in this set of claims, require that the computer program apply a volume control setting. The Examiner states that "a volume control on the computer is set," by Horn. However, this fact does not meet the limitation of the claim. In fact, Applicant finds no

Application No. 09/975,428

RXSD 1017-1

reference to the setting of the volume control by a computer program in Horn. Horn states merely that "Volume control set to high pretesting." at column 4, lines 29-30. There is no discussion of how the volume control is set, and presumably, it is done by the user "pretesting."

Accordingly, rejection under Section 102(e) is improper, and reconsideration is respectfully requested in view of the clarifying amendments.

Rejection of Claim 3 under 35 U.S.C. §103(a)

Claim 3 is rejected under 35 U.S.C. §103(a) as being unpatentable over Horn as applied to claim 1 above. Claim 3 is believed allowable for at least the same reasons as claim 1, from which it depends, and the unique combination recited therein.

Accordingly, reconsideration of rejected claim 3 is respectfully requested.

Rejection of Claims 5-11 and 23-26 under 35 U.S.C. §103(a)

Claims 5-11 and 23-26 are rejected under 35 U.S.C. §103(a) as being unpatentable over Horn as applied to claim 1 above, and further in view of allegedly admitted prior art. Claims 5-11 and 23-26 are believed allowable for at least the same reasons as claims 1 and 22, from which they depend, and the unique combinations recited therein.

Accordingly, reconsideration of the rejection of claims 5-11 and 23-26, as amended, is respectfully requested.

Rejection of Claims 13-15 and 27 under 35 U.S.C. §103(a)

Claims 13-15 and 27 are rejected under 35 U.S.C. §103(a) as being unpatentable over Horn in view of Myer et al. As discussed above with respect to claim 1, the Examiner is mistaken that Horn teaches applying volume control settings as recited in the claims. Furthermore, Myer et al. is unrelated to hearing tests, and computer programs for providing hearing tests on computers. Accordingly, the Examiner has not provided a proper prima facie case of unpatentability as to claims 13-15 and 27.

Accordingly, reconsideration of the rejection of claims 13-15 and 27, as amended, is respectfully requested.

Application No. 09/975,428

RXSD 1017-1

Rejection of Claims 16-20 and 28-32 under 35 U.S.C. §103(a)

Claims 16-20 and 28-32 are rejected under 35 U.S.C. §103(a) as being unpatentable over Horn in view of Myer et al. as applied to claims 13 and 27 above, and further in view of allegedly admitted prior art. Claims 16-20 and 28-32 are believed allowable for at least the same reasons as claims 13 and 27, from which they depend, and the unique combinations recited therein.

Accordingly, reconsideration of the rejection of claims 16-20 and 28-32, as amended, is respectfully requested.

Provisional Rejection of Claims 1-3, 7, 12, 22 and 24 under the judicially created doctrine of obviousness-type double patenting

Claims 1-3, 7, 12, 22 and 24 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 11-14, 18, 19 and 21 of copending Application No. 09/975,047 in view of Horn. Neither the claims of the co-pending application nor Horn suggest a computer program that applies volume control settings for a hearing test, as recited in the claims of the present application, and as discussed in more detail above.

Accordingly, reconsideration of provisional double patenting rejection of claims 1-3, 7, 12, 22 and 24, as amended, is respectfully requested.

Provisional Rejection of Claims 13-15, 18, 21, 27 and 30 under the judicially created doctrine of obviousness-type double patenting

Claims 13-15, 18, 21, 27 and 30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 7-14, 18, 19 and 21 of copending Application No. 09/975,047 in view of Horn and Myer et al. Claims 13-15, 18, 21, 27 and 30 distinguish over the copending application and Horn for at least the same reasons as their respective base claims. Myer et al. does not relate to hearing tests, and does not identify a computer program for setting volume controls in the context recited in the claims of the present application.

Accordingly, reconsideration of the provisional rejection of claims 13-15, 18, 21, 27 and 30, as amended, is respectfully requested.

Application No. 09/975,428

RXSD 1017-1

CONCLUSION

It is submitted that this application is now in condition for allowance, and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fee determined to be due in connection with this communication, or credit any overpayment, to our Deposit Account No. 50-0869 (RXSD 1017-1).

Respectfully submitted,

Dated: 17 June 2004

Mark A. Haynes

Mark A. Haynes, Reg. No. 30,846

HAYNES BEFFEL & WOLFELD LLP
P.O. Box 366
Half Moon Bay, CA 94019
(650) 712-0340 phone
(650) 712-0263 fax